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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/534,882	02/01/2007	David E. Vokey	85533-102	8847
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ADE & COMPANY INC. 2157 Henderson Highway WINNIPEG, MB R2G1P9 CANADA			EXAMINER VALONE, THOMAS F	
			ART UNIT 2858	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/534,882

Applicant(s)

VOKEY ET AL.

Examiner

THOMAS F. VALONE

Art Unit

2858

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 August 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12, 13, 15, 16, 19, 21-24, 26 and 29-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12, 13, 15, 16, 19, 21-24, 26 and 29-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 August 2009 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "10" has been used to designate both "tape" (Fig. 1) and "probe" (Fig. 5 and amended Fig. 6).
2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: The amended specification (8/11/10) includes new part numbers (e.g. 90, 91) which cannot be found in the drawings.
3. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

4. The substitute specification filed 8/11/10 has not been entered because it does not conform to 37 CFR 1.125(b) and (c) because: no page numbers nor any paragraph

numbers can be found in the document, thus preventing any citation of the instant disclosure by the Office.

5. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The phrase added to claim 29, as well as 12 and 21, which claims "each probe includes at least one rigid elongate conductive element" cannot be found in the instant specification presently of record nor in the latest proposed amended specification. Only the phrase, "each probe being a conductive element" has been disclosed by the applicant and has antecedent basis, which presents an entirely different meaning more related to its content, consistent with the use of the term "element" throughout the instant specification to indicate composition, to one of ordinary skill.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 12, 21, 29 and by dependence claims 13, 15, 16, 18-20, 22-26, 30-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The amended claims 12, 21, 29 explicitly claim "each probe includes at least one rigid elongate conductive element" which is confusing as to the design being claimed (nail or staple) and with one element per probe claimed, it is not understood how the

"pair of conductive probes" are constructed as claimed in the amended claims 12, 21 and 29. Unfortunately, they are also similarly disclosed as a "dual prong design", which can be interpreted as a single conventional staple in light of the amendments (3/30/10 and 8/11/10) to the instant specification (p. 6) and inserted with a "standard construction-stapling tool" (PCT WO 2005/010837 disclosure, p. 7). Therefore, it is not clear how, with one element per probe, how a pair can perform any useful function if the "first probe...to penetrate the first conductor" and the "second probe of each pair...to penetrate the second conductor of the tape" as claimed, since this precise arrangement will effectively short out the two conductors electrically, by following such instructions explicitly (one rigid element per probe), to one of ordinary skill, *with a standard industrial staple being interpreted as the pair of probes*. It is not clear how each claimed "probes of each pair" can function any differently than as interpreted above unless they follow a different method that has not been claimed nor disclosed. It is suggested that the term "pair" be deleted from all of the claims if the term does not refer to the pair of conductive probes connected by the disclosed crown, comprising a single staple.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 12, 13, 15, 16, 19, 21-24, 26, 29-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stewart (GB 2235535), Roseneau (4,259,633) both of record, and Rutkowski (3,733,231) in view of Gott (6,175,310).

Regarding claims 12, 18, 21, 29, Stewart from the same field of endeavor teaches a method of detecting moisture in an absorbent material (wood – timber, p. 1) by providing a tape (3, Fig. 6) formed by a substrate and a first and second spaced apart elongate parallel conductors mounted on top of the substrate (1, Fig. 1) and a layer of permeable mounting adhesive on a bottom surface of the substrate (2, p. 3 and Fig. 1). Stewart also teaches a non-hygroscopic material (non-permeable and permeable insulation 8, p. 3 and Fig. 6) applied to the tape. Stewart further teaches attaching the tape using the adhesive to be "fixed to the structure" (p. 3) so as to mount the two conductors on or adjacent to the surface of the building material (Fig. 2-5) as in claim 12, 21, 29. Stewart also teaches applying a voltage (power source 6, p. 3 and Fig. 5, 8) across the two conductors and monitoring currents so as to detect changes in resistance between the conductors caused by moisture in the material (resistance, p. 3) with the same intended use of a conductive probe (permeable adhesive) as in claims 12, 21, 29.

Stewart does not teach penetrating the first and second conductors of the tape by forcing each respective one of a pair of conductive probes such that each of the conductive probes engages into the absorbent material and is electrically connected to the respective conductor. Stewart does not teach conductive probes that are a plurality

of pairs of rigid elongate conductive elements of a corrosion resistant material and does not explicitly teach a substrate of dielectric, hydrophobic material.

Rosenau from the same field of endeavor teaches a pair of probes wherein each probe includes one rigid elongate conductive element of a corrosion resistant material (stainless steel pins, col. 2, line 57) and forcing probes longitudinally into the material (parallel to the grain of the wood, col. 2, line 59) at the respective location so as to penetrate though the surface of the material (28, 30, col. 2, line 50-60 and Figure) such that each of the conductive probes engages into the absorbent material and is electrically connected to the respective conductor.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used a pair of conductive metal probes in the Stewart moisture detector as taught by Rosenau such that each of the conductive probes engages into the absorbent material for the benefit of securely engaging the tape containing each of the first and second conductors to the absorbent material in order to make electrical contact through the conductive probes across the wood for measuring the wood moisture content, as suggested by Rosenau (col. 1, line 45-60).

Stewart as modified by Rosenau (S-R) does not teach conductive probes that are a plurality of pairs of elongate conductive elements longitudinally penetrating the conductors of the tape with a pair of conductive probes and does not explicitly teach a substrate of dielectric, hydrophobic material.

Rutkowski from an analogous field of endeavor teaches penetrating the coating and conductors of an insulated tape (strip 50, Fig. 5) with a plurality of conductive

probes (staples, col. 1, line 60-65 and penetrating teeth 58, col. 3, line 20-25 and Fig. 5) to penetrate the conductors in order to make electrical contact with a conductor of the tape. Rutkowski further teaches the conductive tape is covered with a layer of mounting adhesive (52, col. 1, line 50-55 and col. 3, line 15-20) as in claims 12, 21, 29. Rutkowski further teaches forcing staples (18, col. 1, line 60-70 and Fig. 2) longitudinally along respective spaced locations (every four feet, col. 1, line 65) as in claim 20 along the length of any material being secured including timber frame and wooden truss as they penetrate into almost any material as in claims 12, 18, 21. Furthermore, in light of the instant specification, the applicant admits that such a prior art construction staple can be inserted with a "standard construction-stapling tool" (PCT WO 2005/010837 disclosure, p. 6), which also can be expected to perform the same method as claimed, to one of ordinary skill.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have forced Rutkowski's conductive staple probes that are a plurality of pairs of elongate conductive elements penetrating the conductors of the tape with a pair of conductive probes into the S-R conductors covered with a layer of mounting adhesive as taught by Rutkowski for the benefit of serving as a temporary means of maintaining the tape in proper relation to the absorbent material, as suggested by Rutkowski (col. 1, line 60-70).

The teachings of S-R as modified by Rutkowski (S-R-R) are reviewed above.

S-R-R does not explicitly teach dielectric, hydrophobic material for a substrate.

Gott from the same field of endeavor teaches a dielectric, hydrophobic material for a substrate of the leak detection dual conductor system tape (substrate 21, col. 3, line 48-55) that can be plastic or rubber.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included the Gott hydrophobic dielectric material for a substrate in the S-R-R method for detecting moisture for the benefit of being flexible and no thicker than 20 mils so as not to impede the flow of small droplets of water, as suggested by Gott (col. 3, line 50-55).

10. Regarding claims 13, 22, 30, Stewart teaches a dielectric, non-hydroscopic material (non-permeable and permeable insulation 8, p. 3 and Fig. 6) secured to the top surface of the substrate and extending over the conductors. However, a shorting hazard is also noted in the Stewart reference (p. 3) with the presence of moisture on top of the water permeable layered tape.

11. Regarding claims 19, 26, 33, Stewart teaches the absorbent material is a moisture permeable element of a building construction (timber framed, p. 1 and Fig. 5).

12. Regarding claims 15, 23, 31, the teachings of S-R-R are reviewed above. S-R-R further teaches the content of the tape is metal foil (Rutkowski, col. 1, line 10-15).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included coated metal foil tape conductors as taught by Rutkowski in the S-R moisture detector for the benefit of being easily penetrated by staples or penetrating teeth, as suggested by Rutkowski (col. 1, line 60 and col. 3, line 20-25).

S-R-R does not indicate the width of the tape conductors.

Gott teaches that the width of the conductors is preferably between $\frac{1}{4}$ and 1 inch wide (col. 4, line 10-15), which converts to between 6.5 mm and 25 mm as claimed. Gott further teaches that the conductors are flat metal strips (electroplating, col. 3, line 66 and foil, col. 4, line 1) as in claims 15, 23.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included the Gott recommended flat metal strip conductors of at least 6.5 mm in the S-R-R method for detecting moisture for the benefit of ensuring that the detection tape is sufficiently sensitive to small water droplet moisture (col. 4, line 15-20).

13. Regarding claims 16, 24, 32, S-R-R does not indicate the gap spacing distance of the conductors.

Gott teaches the gap spacing between conductors should be between $\frac{1}{4}$ " and 1.5" which converts to between 6.5 mm and 38 mm, which encompasses the claimed 13 mm range as in claims 16, 24.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included the Gott recommended flat metal strip conductors spacing of at least 13 mm in the S-R-R moisture detection tape for the benefit of facilitating easier connection to various leak detection devices having different terminal spacings, as suggested by Gott (col. 4, line 23-26).

Response to Arguments

14. Acknowledgement is given for the amendment to the specification. However, the objection to the specification has not been withdrawn because the original objection has not been addressed with any page numbers nor paragraph numbers in the specification. Applicant's arguments filed 8/11/10 have been fully considered but they are not persuasive.

15. Regarding the arguments concerning pairs of probes and the drawings, it is noted that no amended drawings have been filed though reference to them are made in the Remarks (8/11/10, p. 12-13)

16. Regarding the argument that the construction staples which are claimed to be an invention which are called a pair of "conductive probes" is now argued (Remarks, 8/11/10, p. 14) to also "be a single pin", it is agreed that a pair of them assembled as claimed, will short out the conductors. As to the argument that "both pins of the probe...penetrate the same conductor" and "measure ... BOTH moisture on the surface AND moisture absorbed in the material" (Remarks, 8/11/10, p. 14-15), it is noted that the features upon which applicant relies are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

17. It is noted also the U-shaped pair of probes being argued are admitted by the applicant to be prior art "well known" (Remarks, 8/28/09, p. 9) and "components are all known" (Remarks, 3/30/10) prior art. Therefore, it is not persuasive that the manner in

which the staples are forced into the leak detecting tape, which is also in the prior art, is somehow an innovative step, since even the tools to do so are in the prior art and the manner in which they are used. Under the principles of inherency, if a prior art device, in its normal and usual operation, would necessarily perform the method claimed, then the method claimed will be considered to be anticipated by the prior art device.

Furthermore, when a prior art device is the same as a device described in the specification for carrying out the claimed method, it can be assumed the prior device will inherently perform the claimed process. *In re King*, 231 USPQ 136 (Fed. Cir. 1986) and MPEP § 2112.02. The applicant is reminded that "The discovery of a previously unappreciated property of a prior art composition....does not render the old composition patentably new to the discoverer." *Atlas Powder Co. v. Ireco Inc.*, 190 F.3d, 1342, 1347, 51 USPQ2d 1943, 1947 (Fed. Cir. 1999). The applicant's claim describes a confusing and contradictory method of inserting construction staples which cannot form the basis for a patentable invention for the reasons stated above.

18. It is noted that the European Patent Office (EPO) review of the PCT application EP 04778218 made of record (1/6/10) also agrees in referring to "a pair of conductive probes penetrating into a material, in order to measure the moisture of that material" with a conclusion (Sheet B) that "This is a known concept (see US4259633) and therefore not a single general inventive concept..." Even the claimed use of two conductors for measuring moisture does not change their conclusion that "This feature is even known from the cited prior art US6175310."

19. Regarding the argument concerning the "bridge portion extending along the conductor" versus "crown" across the two conductors (Remarks, 8/11/10, p. 12), when examining the claimed limitations the difference between the two conditions cannot be distinguished unambiguously, since each probe is claimed to be "one rigid elongate conductive element" in claims 12, 21 and the applicant is further arguing that the probe "can also be any other conductive element such as a nail or pin" (Remarks, 3/30/10, p. 14) also found in the prior art. However, the contradictions become apparent if such an interpretation is used to try to understand the claimed "respective pair of plurality of pairs of conductive probes" for example, as being anything else than the two pins of a staple, thereby sustaining a rejection under 35 USC 112-2nd in the present Office Action.

20. Regarding the argument that Rutkowski does not relate to moisture measurement, it is not persuasive that the claimed method in which the prior art staples are forced into the leak detecting tape, which is also in the prior art, is somehow an innovative discovery, since even the staple gun tools to do so and the insulating tape are in the prior art as well as the claimed manner of forcing staples into the conductors of insulated tape and engage the wood beneath is found in the prior art Rutkowski (col. 1, line 60-65) . Furthermore, the feature that is being argued is found in Roseneau which the applicant admits "discloses a single pair of stainless steel pins (or probes) ... to measure moisture content" and further admits "that such single pairs of probes are previous(ly) known for measurement of moisture" (Remarks, 8/11/10, p. 17). The applicant is hereby notified that the test for obviousness is not whether the features of a

secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

21. Regarding the argument that a pair of pins are generally acknowledged to be somewhat inaccurate and unreliable for high moisture levels and critical levels with serious errors introduced by reverse voltage effects (Remarks, 8/11/10, p. 18), it is not clear what bearing this has on the claimed invention when none of these features and conditions are claimed or even relate to the disclosed invention.

22. Concerning the argument that Stewart and Gott requires a "separate measuring device" (Remarks, 8/11/10, p. 18) it is noted that Stewart and Gott do not disclose any probes since this conductor-penetrating feature is found in the Rutkowski staples and Rosenau (4,259,633) who teaches dual electrode pins (28, 30, Figure) connected to conductors (52, Figure) that "may be driven into the wood at appropriate distance from one another" (col. 2, line 58) which reads on the argument which the applicant is making concerning probes, providing additional prior art motivation to combine staples and moisture detecting tape.

23. Lastly, now that the applicant has explicitly amended the specification to disclose a "conventional staple" (8/11/10), it is noted that MPEP 2112 [R-3]I. specifically cautions the applicant against this type of unpatentable invention application stating, "Something which is old does not become patentable upon the discovery of a new property"

(emphasis added). Furthermore, "The discovery of a previously unappreciated property of a prior art composition...does not render the old composition patentably new to the discoverer." *Atlas Powder Co. v. Ireco Inc.*, 190 F.3d, 1342, 1347, 51 USPQ2d 1943, 1947 (Fed. Cir. 1999).

24. Furthermore, since the applicant desires to continually amend the specification with more details, it is suggested that the filing of a divisional application may better serve the purpose of re-defining the invention more properly with new matter that seems to be required to define over the prior art, for an invention that only uses prior art materials, especially since this is the fourth Office action without any significant progress toward an allowance.

Conclusion

25. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

26. Any inquiry concerning this communication or earlier communications from the examiner should be directed to THOMAS F. VALONE whose telephone number is (571)272-8896. The examiner can normally be reached on M-Tu-W, 9:30-8:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ha Nguyen can be reached on 571-272-1678. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Thomas F Valone/
Examiner, Art Unit 2858

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